

REMARKS

This is a preliminary amendment with request for continued examination filed under 37 C.F.R. 1.114 in response to the final Office Action dated April 13, 2007.

I. ANTICIPATION BASED ON ABRAHAM

Claims 10 to 15 were rejected under 35 U.S.C. 102 (e) as anticipated by Abraham, et al, WO 02/36314 – referred to as "Abraham" herein below.

Claim 10 has now been amended to include the features and limitations of canceled claim 7, which were inadvertently omitted from the newly presented claim 10 in the amendment dated March 13, 2007. As noted in the Office Action on page 3, the REMARKS in the amendment dated March 13, 2007 included a statement that claim 10 included the limitations of canceled claim 7, but unfortunately they were inadvertently omitted from claim 10.

Canceled claim 7 stated that the oscillating blade 20 was designed to be adjustable in the longitudinal direction 55 of the cutting plane 22 in relation to the stationary blade 18. This feature is an important feature that affects the quality of the hair cut that can be produced by the hair cutting machine according to the amended claim 10. Page 11, lines 7 to 9, of the originally filed specification state

the following:

"The fact that the oscillating blade 20 is designed to be adjusted in relation to the stationary blade 18 in the longitudinal direction 55 of the cutting plane 22 makes it possible to adjust the extent of the thinning 40 within certain limits."

The thinning 40 is illustrated in applicant's fig. 12 and is discussed in relation to that figure on pages 8 and 9 of the specification.

Abraham, et al, neither discloses nor suggests that the oscillating blade of their cutting machine is designed to be adjustable in the longitudinal direction of the cutting plane in relation to the stationary blade. In fact, the Office Action dated November 17, 2006 admits that Abraham does not disclose the limitations of canceled claim 7, because claim 7 is not rejected as anticipated by Abraham in this Office Action, although Abraham was used to reject claims 1 to 6 and 8.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the judicial opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

For the foregoing reasons and because of the changes in claim 10, withdrawal of the rejection of claims 10 to 15 as anticipated under 35 U.S.C. 102 (e) by Abraham, et al, WO 02/36314, is respectfully requested.

II. CLAIMS 10 TO 15 ARE NOT OBVIOUS

It is respectfully submitted that the above amended claims 10 to 15 are not

obvious from Abraham, et al, WO 02/36314, with or without any of the other prior art references of record.

The adjustability of the oscillating blade 20 in the longitudinal direction is not the only difference between the claimed invention according to claim 10 and the hair cutting machine of Abraham. Another important difference is the relative position of the oscillating blade and the stationary blade in the hair cutting head. In the case of the applicants' hair cutting machine if the hair cutting machine is held horizontally by the handle as shown in figs. 5 and 6 the oscillating blade 20 is above the stationary blade 18. On the other hand, in the case of the hair cutting machine shown in figs. 4 to 7 of Abraham the oscillating blade 57 would be below the stationary blade 55 if the hair cutting machine were held by its handle in the same manner as shown in figs. 5 and 6.

The foregoing difference in the positions of the oscillating blade and the stationary blade relative to the handle leads to an important difference in the manner in which the hair can be cut by the two machines. This is explained on page 2, lines 10 to 20, of the applicant's specification, where it states the following:

"With the handle of the hair cutting machine in the operating position, because the cutting plane is inclined downward in relation to the longitudinal axis of the handle, with the oscillating blade disposed above the stationary blade, the oscillating blade on the cutter head of the hair cutting machine is oriented so that the oscillating blade....continuously guide strands of hair into the stationary blade, which produces a fine, dense thinning of hair.... achieving a cutting result with a hair cutting machine equal to that of a scissors cut."

The specification goes on to state on page 2, lines 21 to 24, that:

"One advantage of the hair cutting machine according to the present invention is that it can mechanically produce a haircut that gives a visual impression similar to

that of the classic scissors cut without the danger of injury to the scalp."

Claim 10 currently contains an expression of the foregoing relationship between the positions of the oscillating blade and the stationary blade in relation to the handle in lines 5 to 7, for example. This relationship is the opposite from that in the hair cutting machines of both Abraham and DE '706, the latter reference disclosing the longitudinal adjustability of the oscillating cutting blade.

Furthermore the angular range that the cutting plane encloses in relation to the axis of the handle for the hair cutting machine in claim 10 differs from that of Abraham. This limitation is found in about lines 11 to 12 of applicants' claim 10. According to the attached modified fig. 7 from the specification in the hair cutting machine of Abraham the angle α is in a range from -45° to -90° , whereas according to claim 10 the angle α is positive and in a range from 0 to 90° .

The attached modified fig. 7 is not intended to be an additional figure that is to be added to the figures published in the issued patent, but is only intended as a figure that is helpful in understanding the above-described relationships between the positions of the oscillating blade and stationary blade and the handle of the hair cutting machine. In other words, it is to help understand these REMARKS but is not an addition to the drawing.

It is well established that a reference, such as Abraham, that teaches the opposite from a claimed invention should not be used alone or combined with other prior art references under 35 U.S.C. 103 to reject the claimed invention as obvious. See M.P.E.P. 2145. X. Also note that the Federal Circuit Court of Appeals has said:

**"A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered."
Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q.
416 (Fed. Cir. 1986)**

Thus Abraham should not be combined with other prior art references under 35 U.S.C. 103 (a) to reject the invention claimed in claims 10 to 15, because it contains teaching of the opposite from the hair cutting machine claimed in claim 10, especially in relation to the relative positions of the oscillating blade and the stationary blade.

For the foregoing reasons favorable allowance of the above claims 10 to 15 is respectfully solicited.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

/ Michael J. Striker /

Michael J. Striker,
Attorney for the Applicants
Reg. No. 27,233